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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3684

NOTIFICATION DATE

DELIVERY MODE

02/01/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tmunoz@hamiltontertile.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/895,458	<b>Applicant(s)</b> ALLEMANN ET AL.	
	<b>Examiner</b> Susanna M. Diaz	<b>Art Unit</b> 3684	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 56-85 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 56-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This final Office action is responsive to Applicant's amendment filed January 14, 2010.

Claims 1 and 71-84 have been amended.

Claims 1-13 and 56-85 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed January 14, 2010 have been fully considered but they are not persuasive.

The previous rejection of claims 1-13 and 56 under 35 U.S.C. § 101 has been withdrawn in response to Applicant's claim amendments. However, the rejection of claims 71-85 under 35 U.S.C. § 101 is maintained. On page 12 of the response, Applicant submits, "Claims 71-85 have been amended to recite a 'tangible computer readable medium', thus, excluding 'signals' as proscribed by *in re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007)." First, Applicant has not amended the specification in such a manner that surrenders scope to "radio waves, microwaves, and other electromagnetic and/or optical carriers" (i.e., the transitory media). Second, in the *Nuijten* decision, signals are recognized as being tangible since they are perceptible, yet signals *per se* are still deemed to be non-statutory since they are "transitory." In order to exclude non-statutory media from the scope of claims 71-85, Applicant might consider adding in language along the lines of the computer readable medium being "non-transitory" (which would be interpreted as a surrender of scope of the claimed computer readable

medium such that the claimed computer readable medium explicitly excludes interpretation as "radio waves, microwaves, and other electromagnetic and/or optical carriers," i.e., all transitory media).

Applicant argues that "none of the Alerts [of Beaven] are related to 'alignment between the modified primary goal and the secondary goal' as required by claims 1, 57, and 71." (Page 13 of Applicant's response) Applicant further submits that Beaven "neither teaches nor suggests 'if the primary goal has been determined to have been modified, generating an alignment warning with the computer system to provide notice regarding alignment between the modified primary goal and the secondary goal' as required by claims 1, 57, and 71." (Page 14 of Applicant's response) As explained in the art rejection, Beaven discloses a goal management system that is manipulated using a user interface (Beaven: Pages 44-88). A user can link "strategic corporate goals and Information Technology initiatives" (Beaven: Page 16, lines 19-20), view existing goals within a hierarchy to help determine whether some existing goals are no longer appropriate (Beaven: Page 17, lines 6-10; Page 19, lines 7-9, 22-24; Page 24, lines 10-22), and view the progress of contributing goals toward the parent goal (Beaven: Page 22, lines 1-8; Page 30, lines 12-24). Beaven further discloses that "Users can also execute searches by name or word in the title of a goal or project, and can put Alerts in place that will flag changes that occur in goals or projects previously indicated as being of particular interest." (Beaven: Page 21, lines 8-11) Beaven clearly tracks goals as they contribute to a project or parent goal. Also, Beaven allows for alerts of modified goals, which at least suggests the ability to track modified goals that

Art Unit: 3684

are connected to other goals, particularly in combination with the teachings of eWorkbench.

Additionally, Applicant has not fully addressed the rejection as it stands. More specifically, Applicant has not addressed the following analysis from the art rejection:

Furthermore, it is noted that the step of generating an alignment warning is only performed "if the primary goal has been modified." If the primary goal is not modified, this step is not performed within the scope of the claimed invention. Additionally, the content of the alignment warning is non-functional descriptive material. Such content details are not functionally involved in the manipulative steps of the invention nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The manipulative steps of the invention would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); *In re Ngai*, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); MPEP § 2106.

Until the claims are amended in such a fashion that the generation of the alert becomes more than optional ("if the primary goal has been determined to have been modified") and the content of the alert itself becomes more than non-functional, descriptive material, Applicant's arguments are for these additional reasons deemed to be moot.

Regarding the Double Patenting rejection, Applicant argues that the inclusion of the alignment warning details in the claims in the instant application obviates the Double Patenting rejection since such details are not obvious to add to the claims in the related patent. The Examiner respectfully disagrees. As discussed above, these details are not only addressed by the eWorkbench-Beaven combination, but many of these details are part of optional claim language (as part of a conditional statement) and/or comprise non-functional descriptive material, which does not serve to patentably limit the claimed invention.

In conclusion, Applicant's arguments are not persuasive.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 71-84 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Page 17 of the specification states, "The data storage devices may also be referred to as computer-usable media. Additional computer-usable media include, without limitation, transmission media such as wires, radio waves, microwaves, and other electromagnetic and/or optical carriers." Claims 71-84 are directed toward a "tangible computer readable medium comprising code stored therein and executable by a processor." Based on Applicant's disclosure, the medium may be interpreted as

“radio waves, microwaves, and other electromagnetic and/or optical carriers,” all of which are non-statutory media. Therefore, claims 71-84 are non-statutory.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8, 56-64, 70-78, 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over eWorkbench, as disclosed in Meyer (“eWorkbench: Real-time Tracking of Synchronized Goals”), Dutton (“Making Reviews More Efficient and Fair”) and Mottl (“Appraisal Software Ends HR Paper Chase”), *in view of* Beaven et al. (US 2004/0186762 A1). [The date of the provisional application to which Beaven claims priority (application no. 60/133,152) is relied upon to predate the earliest priority date of the instant application. Since there is an intervening Continuation-in-Part application in the priority chain of Beaven, the Examiner herein cites excerpts directly from provisional application no. 60/133,152 to ensure that only subject matter predating Applicant’s priority date of June 29, 2001 is relied upon in Beaven. (A copy of the provisional application may be accessed via the Public PAIR web site.)]

eWorkbench discloses a guidance method of maintaining goals using a computer system with at least first and second goal types so as to promote goal alignment, the guidance method comprising:

[Claim 1] providing a first rule for relationships between goals of the first goal type (Meyer: ¶¶ 4, 15 -- Associating a set of goals with a particular person is an example of a rule for each set of goals);

providing a second rule for relationships between goals of the first goal type and goals of the second goal type (Meyer: ¶¶ 4, 15 -- A linkage between a worker's goals and those of his/her manager is an example of a second rule for relationships between goals of a first goal type, e.g., those belonging to a worker or manager, and goals of a second goal type, e.g., those belonging to a manager or worker);

storing a primary goal of the first goal type (Meyer: ¶¶ 4, 15 -- The fact that goals of both the managers and workers can be tracked over time, compared, and displayed in a report means that the goal-related data must be stored. It should be noted that a "primary" goal is merely a non-functional, descriptive label of a goal; therefore, any goal established by a manager or worker may be a primary goal of the first goal type);

determining content for a user interface, based on the first and second rules, such that the content facilitates goal alignment (Meyer: ¶¶ 2, 4, 15 -- A hierarchy of goals is displayed in relation to a user and his/her subordinates, for example; Dutton: ¶ 10);

performing using a computer system:



storing the secondary goal of the second goal type (Meyer: ¶¶ 4, 15 – The fact that goals of both the managers and workers can be tracked over time, compared, and displayed in a report means that the goal-related data must be stored. It should be noted that a “secondary” goal is merely a non-functional, descriptive label of a goal; therefore, any goal established by a manager or worker may be a secondary goal of the second goal type);

[Claim 2] determining content for user interfaces comprises automatically customizing content for a screen capable of being displayed by the wizard, based on at least one of the first rule and the second rule (Meyer: ¶ 4: “By clicking on the ‘Align’ button, the user is presented with a list of his manager’s goals; he then clicks on the appropriate one to link it with his own. Managers also can create and automatically cascade goals down to their direct reports”; Meyer: ¶ 15: “eWorkbench can provide a report that documents the hierarchy of aligned goals. This report shows how goals are connected to one another and who owns what”).

Regarding claims 1-4 and 56, eWorkbench does not explicitly disclose that the user interface directs a user of the user interface in generation of content of a secondary goal of the second goal type that causes alignment of the secondary goal with the primary goal of the first goal type; however, Beaven discloses a goal management system that is manipulated using a user interface (Beaven: Pages 44-88). A user can link “strategic corporate goals and Information Technology initiatives” (Beaven: Page 16, lines 19-20), view existing goals within a hierarchy to help determine

Art Unit: 3684

whether some existing goals are no longer appropriate (Beaven: Page 17, lines 6-10; Page 19, lines 7-9, 22-24; Page 24, lines 10-22), and view the progress of contributing goals toward the parent goal (Beaven: Page 22, lines 1-8; Page 30, lines 12-24).

Beaven further discloses that "Users can also execute searches by name or word in the title of a goal or project, and can put Alerts in place that will flag changes that occur in goals or projects previously indicated as being of particular interest." (Beaven: Page 21, lines 8-11) The ability to link to related data, e.g., "with the domain structure linked to goals and initiatives and with knowledge linked to the goals and initiatives, the organization is provided with a clear and natural organization for placing and locating critical information when needed." (Beaven: Page 32, lines 1-4) Similarly, Beaven discloses how the various user interfaces provide access to information in such a way that a user decision is facilitated more easily (e.g., see pages 33-34 of Beaven). Both eWorkbench and Beaven are directed toward goal management within an organization; therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify eWorkbench such that the user interface directs a user of the user interface in generation of content of a secondary goal of the second goal type that causes alignment of the secondary goal with the primary goal of the first goal type in order to provide access to information in such a way that a user decision is facilitated more easily (as suggested on pages 32-34 of Beaven).

Further regarding claims 1 and 85, eWorkbench does not explicitly disclose determining, with the computer system, if the primary goal has been modified and, if the primary goal has been determined to have been modified, generating an alignment

Art Unit: 3684

warning with the computer system to provide notice regarding alignment between the modified primary goal and the secondary goal, wherein generating an alignment warning comprises generating an alignment warning for display to alert a viewer of the display of the alignment warning (claim 1), wherein generating an alignment warning comprises presenting a message on a computer display (claim 85). However, as discussed above, Beaven discloses that "Users can also execute searches by name or word in the title of a goal or project, and can put Alerts in place that will flag changes that occur in goals or projects previously indicated as being of particular interest."

(Beaven: Page 21, lines 8-11) Effectively, Beaven's users can link primary and secondary goals and they can also generate alerts when any types of goals are changed. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify eWorkbench to perform the steps of determining, with the computer system, if the primary goal has been modified and, if the primary goal has been determined to have been modified, generating an alignment warning with the computer system to provide notice regarding alignment between the modified primary goal and the secondary goal, wherein generating an alignment warning comprises generating an alignment warning for display to alert a viewer of the display of the alignment warning (claim 1), wherein generating an alignment warning comprises presenting a message on a computer display (claim 85) in order to help users keep abreast of changing circumstances (as seen in page 19, lines 20-24 of Beaven) by providing these users "with information that can help the user decide where to commit resources based on factors such as benefit and risk. In

another example, when managers meet and want to focus on key implementation issues, they can opt to switch to viewing 'status' factors (see Fig. 18a) and can view which goals or projects are on track or in need of attention, which stage each is in, risks, whom is responsible." (Beaven: Page 20, lines 9-14) In other words, implementing Beaven's goal tracking and alerting features would enhance eWorkbench by allowing users to more effectively manage and respond to any goal changes, as suggested by Beaven. Furthermore, it is noted that the step of generating an alignment warning is only performed "if the primary goal has been modified." If the primary goal is not modified, this step is not performed within the scope of the claimed invention. Additionally, the content of the alignment warning is non-functional descriptive material. Such content details are not functionally involved in the manipulative steps of the invention nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The manipulative steps of the invention would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); MPEP § 2106.

Further regarding claim 3, eWorkbench allows workers and managers to associate goals with the people and departments in charge of the goals as well as with parent goals from a list of parent goals (Meyer: ¶¶ 2-4, 9), yet eWorkbench does not expressly teach that the team is selected from a drop-down list of teams. However, Beaven's interactive software programming conveniently allows users to make selections from a drop-down list (Beaven: Pages 46, 48, 49, 54-56, 58, 61, 62, 78-79, 83-88) and owners and teams may be assigned to the various goals (Beaven: Pages 48-49). Therefore, since eWorkbench's workers may have to align their goals with multiple available managers, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify eWorkbench to allow users to select a team from a drop-down list of teams in order to facilitate more efficient access to and evaluation of the available team options.

Additionally, as per claims 4 and 5, eWorkbench does not expressly teach, in response to modification of the secondary goal, automatically determining whether a child goal exists for the secondary goal and, in response to determining that the child goal does exist, automatically flagging the child goal to cause a user interface for an owner of that child goal to indicate that the child goal should be checked for alignment (claim 4). eWorkbench also fails to expressly disclose determining that the owner has verified the alignment of the child goal and, in response to determining that the owner has verified the alignment, automatically unflagging the child goal (claim 5). However, as discussed above, Beaven discloses that "Users can also execute searches by name or word in the title of a goal or project, and can put Alerts in place that will flag changes

that occur in goals or projects previously indicated as being of particular interest."

(Beaven: Page 21, lines 8-11) Effectively, Beaven's users can link primary and secondary goals and they can also generate alerts when any types of goals are changed. Therefore, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify eWorkbench to perform the steps of claims 4 and 5 in order to promote a clearer understanding of each worker's required contributions toward meeting a child goal, e.g., by providing these users "with information that can help the user decide where to commit resources based on factors such as benefit and risk. In another example, when managers meet and want to focus on key implementation issues, they can opt to switch to viewing 'status' factors (see Fig. 18a) and can view which goals or projects are on track or in need of attention, which stage each is in, risks, whom is responsible." (Beaven: Page 20, lines 9-14) In other words, implementing Beaven's goal tracking and alerting features would enhance eWorkbench by allowing users to more effectively manage and respond to any goal changes, as suggested by Beaven.

Regarding claim 6, eWorkbench does not expressly teach that the step of determining content for the user interface comprises automatically flagging the goal for supervisory approval in response to determining that the user has a supervisor. However, eWorkbench does make it clear that worker goals are linked with those of their bosses, "all the way to the top" (Meyer: ¶ 2). "eWorkbench is a practical vehicle for obtaining real-time information on progress toward goals at every level of the organization...eWorkbench helps assure that everyone from top to bottom in an

organization understands how they contribute to business results" (Meyer: ¶17).

Clearly, eWorkbench envisions visibility of goal alignment through the organization.

Beaven discloses that "Users can also execute searches by name or word in the title of a goal or project, and can put Alerts in place that will flag changes that occur in goals or projects previously indicated as being of particular interest." (Beaven: Page 21, lines 8-11) Effectively, Beaven's users can link primary and secondary goals and they can also generate alerts when any types of goals are changed by providing these users "with information that can help the user decide where to commit resources based on factors such as benefit and risk. In another example, when managers meet and want to focus on key implementation issues, they can opt to switch to viewing 'status' factors (see Fig. 18a) and can view which goals or projects are on track or in need of attention, which stage each is in, risks, whom is responsible." (Beaven: Page 20, lines 9-14) In other words, implementing Beaven's goal tracking and alerting features would enhance eWorkbench by allowing users to more effectively manage and respond to any goal changes, as suggested by Beaven. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify eWorkbench such that the step of determining content for user interfaces comprises automatically flagging the goal for supervisory approval in response to determining that the user has a supervisor in order to facilitate the ability of high-level management to efficiently monitor the performance of both managers and their subordinates and respond to any problems that might affect the organization's ability to meet its goals.

eWorkbench discloses a guidance process of maintaining goals in a system with at least first and second goal types so as to promote goal alignment, the guidance process comprising:

[Claim 7] wherein determining content for the user interface comprises:

populating objects for a graphical user interface with alignment information and warnings (Meyer: ¶¶ 2-5, 7, 9, 16); and

providing connections to tools for checking alignment (Meyer: ¶¶ 2-5, 7, 9, 16);

[Claim 8] wherein populating objects for a graphical user interface with alignment information and warnings comprises specifying an appearance for at least one of a manager warning object, a feedback warning object, and an alignment warning object (Meyer: ¶¶ 2-5, 7, 9, 16).

[Claims 57-64, 70] Claims 57-64 and 70 recite limitations already addressed by the rejection of claims 1-8 and 56 above; therefore, the same rejection applies.

[Claims 71-78, 84] Claims 71-78 and 84 recite limitations already addressed by the rejection of claims 1-8 and 56 above; therefore, the same rejection applies.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct



Art Unit: 3684

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-8, 56-64, 70-78, 84, and 85 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-38 of U.S.

Patent No. 7,110,988. Although the conflicting claims are not identical, they are not patentably distinct from each other because deleting elements from the claims in the related patent would have been obvious. Elimination of an element or its functions is deemed to be obvious in light of prior art teachings of at least the recited element or its functions (see *In re Karlson*, 136 USPQ 184, 186; 311 F.2d 581 (CCPA 1963)).

Additionally, the limitations recited in claims 1-8, 56-64, 70-78, 84, and 85 of the instant application, but not recited in the related patent, are deemed to be obvious features to combine with the claimed invention of the patent because the references cited in the art rejection above collectively teach all of the claimed features and combination of these missing features with the claimed invention of the related patent would have yielded predictable and expected results and all features would operate the same in combination as they do separately.

***Allowable Subject Matter***

9. Claims 9-13, 65-69, and 79-83 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and to overcome any applicable Double Patenting rejections and rejections under 35 U.S.C. § 101.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/  
Primary Examiner, Art Unit 3684